

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE PATENT
APPLICATION OF: Danny A. GRANT *et al.*
SERIAL NO.: 10/538,161
ATTORNEY DOCKET
NO.: IMM152D (I103 1940US.3)
FILING DATE: June 19, 2006
ART UNIT: 2629 CONFIRMATION No.: 3262
EXAMINER: Seokyun Moon
FOR: Methods and Systems for Providing a Virtual Touch Haptic Effect to
Handheld Communication Devices

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Final Office Action mailed **May 11, 2010** (hereinafter "Final Action"), Appellants request a review of the Final Action in the above-referenced application. This request is being filed concurrently with a Notice of Appeal.

The review is requested for at least the reasons set forth in the **Remarks** beginning on page 2 of this paper.

A total of 5 pages are provided.

It is not believed that extensions of time or fees for net addition of claims are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned for under 37 C.F.R. § 1.136(a), and any fees required therefore (including fees for net addition of claims) are hereby authorized to be charged to our Deposit Account No. 090528 (Ref. No. **54446.0285.8**).

REMARKS

Claims 1-16 and 19-30 are pending in the application. Claims 1-16 and 19-30 stand rejected. In view of the following Remarks, allowance of all the claims pending in the application is respectfully requested.

Rejection Under 35 U.S.C. § 101

The Examiner has rejected claims 10-16 and 30 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Appellants traverse this rejection for at least the reason that the claims recite a “tangible computer-readable storage medium,” which does not include intangible transitory signals. Accordingly, the rejection of the claims is improper and should be reversed.

Rejection Under 35 U.S.C. § 103

The Examiner has rejected claims 1-4, 10-12, and 19-23 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent Publication No. 2002/0177471 to Kaaresoja (“Kaaresoja”) in view of U.S. Patent No. 6,901,273 to Lutnaes (“Lutnaes”). Appellants traverse this rejection because the references relied upon by the Examiner do not teach or suggest all the features of the claimed invention.

The Examiner has rejected claims 5-9, 13-16 and 24-30 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kaaresoja. Appellants traverse this rejection because Kaaresoja does not teach or suggest all the features of the claimed invention.

1. The references relied upon by the Examiner do not teach or suggest requesting contact with different user interface members when different virtual touches are received as recited by claims 1, 10, and 19

Claim 1 recites, among other things: “outputting, at the first communication device, a request to initiate a contact with the first user-interface member when the first virtual touch is received and a second request to initiate a contact with the second user-interface member when the second virtual touch is received.” Claims 10 and 19 recite similar features. In other words, the claims recite requests to initiate a contact with different user-

interface members ("first and second user-interface members") when different virtual touches ("first and second virtual touches") are received.

Appellants' Specification at, for example, paragraph 0045 describes that a virtual touch may include, among other things, various haptic effects that simulate various touch sensations. For instance, a user may receive different touch sensations associated with different user interface members after being requested to contact the different user interface members.

In the Final Action, the Examiner acknowledges that Kaaresoja does not teach or suggest at least this feature of the claims. *Final Action* at page 10, lines 5-8. Instead, the Examiner invokes Official Notice, alleging that common knowledge cures this deficiency of Kaaresoja. *Final Action* at page 10, lines 9-13. In particular, the Examiner alleges that it is "common in the art that the display of a mobile phone outputs a request to initiate a contact with an user-interface member...to open a text message." *Final Action* at page 10, lines 9-13. However, even if this is true, it is not common knowledge to request a contact with ***different user-interface members to open different text messages***.

The Examiner apparently acknowledges this as well, but nonetheless concludes that "it would have been obvious to modify the method of Kaaresoja to output first and second requests to initiate contacts with ***the*** user-interface member when the first communication device receives a first and second new text message from the second communication device, in order to inform the user...that the new text messages are arrived [*sic*]." *Final Action* at page 10, lines 14-18. In the next page of the Final Action, the Examiner attempts to cure this deficiency of Kaaresoja and alleged common knowledge by concluding that Lutnaes teaches the "concept of including two user-interface members [of Lutnaes]...in a communication device, to operate the communication device."

However, it is wholly unclear how use of two user interface members to operate a communication device renders obvious requests to initiate a contact with different user-interface members when different virtual touches are received. Such a broad characterization of the alleged teaching of Lutnaes does not provide a reasoned articulation justifying a conclusion of obviousness. For instance, merely teaching use of two user interface members to operate a device does not teach or suggest requests to contact different user interface members to receive different virtual touches.

Absent a reasoned articulation of how the combination of Kaaresoja, alleged common knowledge, and Lutnaes render the claims obvious, the Examiner has engaged in improper hindsight using Appellants' disclosure as a roadmap to arrive at the features recited by the claims. Thus, the Examiner has failed make a prima facie case that Kaaresoja, alleged common knowledge, and Lutnaes, either alone or in combination with one another, render obvious requests to initiate a contact with different user-interface members when different virtual touches are received. For at least these reasons, Kaaresoja, either alone or combined with alleged common knowledge, fails to teach or suggest all the features of the claimed invention. Accordingly, the rejection is improper and should be reversed.

2. Claims 5, 13, and 24

Kaaresoja does not teach or suggest at least the feature of "the virtual touch indicator indicates a particular one of the plurality of user-interface members to be contacted by an operator of the first communication device to receive the virtual touch" as recited in amended claim 5. Claims 13 and 24 have been amended to recite similar features. As previously noted above with regard to the Examiner's taking of Official Notice, it is not common knowledge to request a contact with different user-interface members to open different text messages. Thus, it is not common knowledge to indicate a particular one of the plurality of user-interface members to be contacted as claimed. For at least these reasons, Kaaresoja, either alone or combined with alleged common knowledge, fails to teach or suggest all the features of the claimed invention. Accordingly, the rejection is improper and should be reversed.

3. Remaining Pending Claims

Claims 2-4, 6-9, 11, 12, 14-16, 20-23, and 25-30 depend from and add features to one of claims 1, 5, 10, 13, 19, and 24. As such, for at least the reasons discussed above with regard to claims 1, 5, 10, 13, 19, and 24, the rejection of these dependent claims is improper and should be reversed.

CONCLUSION

Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the Application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Date: **August 11, 2010**

Respectfully submitted,

By:



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